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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,785	03/13/2001	Russell E. Evans	259/225	2980

7590

06/04/2003

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EXAMINER

FINEMAN, LEE A


ART UNIT

PAPER NUMBER

2872

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/804,785	Applicant(s) EVANS ET AL. 
	Examiner Lee Fineman	Art Unit 2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to an amendment filed 05 December 2002 in paper number 9 in which claim 10 was amended and claims 36-38 were added and claims 13-30 were cancelled. Claims 1-12 and 31-38 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 5-12, and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum, US Patent No. 4,873,029 in view of Slagel, US Patent No. 6,127,505.

Blum discloses an optical-quality polarized part comprising an optical construct, which is a lens substrate, (fig 5, fig. 7) and a polarizer having a first side and an opposing second side (33) integrally bonded to the optical construct and comprising a wafer (column 6, lines 15-19) and a hard coating integrally bonded to the optical construct (column 4, lines 32-35) or the polarizer (column 5, lines 39-47). Blum does not disclose the optical construct comprising a high impact polyurethane-based optical material.

Slagel teaches an optically clear high impact polyurethane-based optical material (column 2, lines 4-10) comprising a polyurethane prepolymer including a dye or colorant (column 6, lines 7-10, table 1) wherein the prepolymer comprises up to about 12 molar percent of trimethylol propane (column 5, line 65-column 6 line 5), and wherein the high impact

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polyurethane-based optical material comprises a reaction product of (a) a polyurethane prepolymer prepared by reaction of a methylenebis (cyclohexyl isocyanate) with an OH-containing intermediate having a weight average molecular weight between about 500 and about 1,200 selected from the group consisting of polyester glycols, polyether glycols, and mixtures thereof in an equivalent ratio of 2.5 to 4.0 NCO/1.0 OH and (b) an aromatic diamine curing agent in an equivalent ratio of about .9 to 1.1 NH₂/1.0 NCO (column 1, line 59-column 2, line 3 and column 3, lines 16-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the optical material of Slagel to make the optical construct of Blum to provide impact resistance.

3. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum in view of Slagel as applied to claim 1 above, and further in view of Kausch et al., US Patent No. 6,113,811.

Blum in view of Slagel discloses the claimed invention except for the polarizer comprising a polyethylene terephthalate film or at least one layer supporting a polyvinyl alcohol film. Kausch et al. teaches a polarizer comprising a polyethylene terephthalate film (column 10, lines 52-57) and a layer supporting a polyvinyl alcohol film (column 2, lines 36-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the polarizer of Kausch in the optical-quality polarized part of Blum in view of Slagel to reduce glare (Kausch, column 1, line 13).

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4. Claims 1 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhalakia et al., US Patent No. 5,827,614 in view of Slagel, US Patent No. 6,127,505.

Bhalakia et al. discloses an optical-quality polarized part comprising an optical construct (12, fig. 1) made of a high impact polycarbonate material, and a polarizer (14 or 20, column 7, lines 12-14) integrally bonded to the optical construct (fig. 1, column 4, lines 51-53) and comprising a wafer (column 6, lines 33-35) of a material selected from the group consisting of polycarbonate, poly(methyl methacrylate), polystyrene, cellulose acetate butyrate (CAB), cellulose acetate, and cellulose triacetate (column 7, lines 23-59) and having a thickness of less than 0.2 mm (column 11, lines 15-16). Bhalakia et al. does not disclose the optical construct comprising a high impact polyurethane-based optical material.

Slagel teaches an optically clear high impact polyurethane-based optical material (column 2, lines 4-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the optical material of Slagel to make the optical construct of Bhalakia et al. to provide an even higher impact resistance than the polycarbonate material (Slagel, column 1, lines 23-25 vs. Table III).

Response to Arguments

5. Applicant's arguments filed 05 December 2002 have been fully considered but they are not persuasive.

The applicant alleges that the combination of the material of the secondary reference with the lens of the primary reference has several problems: 1) displacement of the polarizer and 2) heat damage. Since, the claim is not limited to a product without these deficits, it would appear that the claims read on the combination.

Further, the applicant appears to be alleging even if the combination would have been obvious, it would be inoperative. MPEP 2121 sets forth "Even if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991). The prior is assumed to be enabling. Since the applicant has failed to establish any evidence to purported problems or deficiencies in the previous attempts to combine the teaching of the reference, the prior is then taken as being enabling to one of ordinary skill.

Additionally the applicant argues various points regarding difficulty integrally bonding the lens substrate and polarizing wafer as well as the problems stated above. Again, the applicant has failed to provide evidence showing the problems of using a high impact polyurethane-based optical material with a polarizer. A mere allegation of patentability is not sufficient.

6. It is noted by the Examiner that the drawing and claim objections made in the previous Office Action have been withdrawn due to amendment and persuasive arguments presented by the Applicant.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF
May 29, 2003


MARK A. ROBINSON
PRIMARY EXAMINER